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| EXAMINER | |
|---|---|
| GARBER, CHARLES D | |

| ART UNIT | PAPER NUMBER |
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| 2856 | |

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/046,451 | LEONARD ET AL. | |
| | Examiner | Art Unit | |
| | Charles D. Garber | 2856 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 23-50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 23-29 and 32-50 is/are rejected.

7)☒ Claim(s) 30 and 31 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

á)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to claims 23-48 and 50 have been considered but are moot in view of the new ground(s) of rejection.

Examiner does not agree with Applicant's assertion that changes to the claims "merely address informalities". At least changes to independent claims 1, 46 and 50 substantively change the scope of the invention. With respect to claim 1, the container has been amended to positively include a "closure". With respect to claim 46, the aperture in the container has been amended to be "in a wall". With respect to claim 50, the forming of an aperture has been amended to occur "after immersion". These changes effectively overcome the prior art as applied in earlier rejection of the aforementioned claims and their depending claims, and necessitate the new ground(s) of rejection presented in this Office action.

Applicant's arguments with respect to claim 49 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "forming an aperture in the container with a device that penetrates a wall of the container **after** the container is secured in a clamp [emphasis added]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 23, 25, 28, 39, 41, 43, 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Fielibert et al. (US Patent 3,855,531) in view of Karp (US Patent 1,042,558).

Regarding claims 23 and 25, Fielibert discloses a method of testing seals of food containers. The recitation that the container is "liquid-filled" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Fielibert discloses the container 2 has a closure (separate flat portion shown on the top of the inverted container in figures 1 and 3). Electrolytic bath 1 is shown in the figures with at least a portion of a the container having the closure extending into the tank such that the closure of the container is submerged in the liquid.

Fielibert lacks a clamp having a first and second member for securing a container between the members and a ram connected to the clamp to provide relative movement between the first and second members.

Karp discloses a machine for leak testing container sealed ends by submersion teaching seat 10, head 5b, and pulling down rod 19 equivalent to first and second clamp members and ram of the instant invention (see figures 2 and 3). Initial movement of the rod (initiated by a foot operated pedal 20) secures the container, immerses the container and initiates the test in one operation. Releasing the rod (by lifting the foot) stops the test, raises the can and releases it for further testing of containers (page 1 line 95 to page 2 line 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide clamp members and a rod or ram for bringing the clamp members together around a container to be tested so that the container may be immersed and tested in one operation providing for a "simple and efficient means for testing" many containers.

As for claim 28, Fielibert discloses needle 6 which is means for forming an aperture in a container 2.

As for claim 39 Fielibert further discloses measuring conductivity or resistance with a measuring device comprising a voltage source, ammeter and electrodes (column 1 line 54, column 2 lines 49-51) penetrating the interior and electrolyte bath as shown in the figures. The level of current flow gives an indication of the effectiveness of the seal.

As for claim 41, Fielibert further shows electrode (needle) moveable and sized to fit the hole it makes.

As for claims 43 and 45, Fielibert shows the alternative means of forming an aperture as a needle or punch as well as an electrode.

Claims 46-48 are considered to be substantively equivalent to claim 39 as discussed above.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Fielibert et al. (US Patent 3,855,531) as modified by Karp (US Patent 1,042,558) and applied to claim 23 above and further in view of Monteiro (US Patent 5,501,435)

Regarding claim 24, the reference lack the ram actuated alternatively by pneumatic, hydraulic or electromotive power.

Monteiro discloses a manual clamping device teaching "clamping can be activated and deactivated with different driving options, including, but not limited to manual, pneumatic, or hydraulic operation." (column 1 lines 49-52)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use pneumatic or hydraulic operation of a clamp as "each option has operational advantages associated therewith."

Claim 26, 38, 40, 42, 44 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Fielibert et al. (US Patent 3,855,531) as modified by Karp (US Patent 1,042,558) and applied to claim 23 above and further in view of Widmer et al. (US Patent 3,712,112).

Regarding claim 26, The references lack means forming an aperture in a container while being secured in a clamp.

In a device for testing sealed containers Widmer teaches needle 9 piercing container 21 during the pressing process that clamps the container between die 5 and cover 19 (see figure and column 2 lines 3, 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to pierce the container while clamping in order to save an step in the preparation of the container for testing and thereby save test time.

As for claim 38 Fielibert further discloses measuring conductivity or resistance with a measuring device comprising a voltage source, ammeter and electrodes (column 1 line 54, column 2 lines 49-51) penetrating the interior and electrolyte bath as shown in the figures. The level of current flow gives an indication of the effectiveness of the seal.

Claim 50 is considered to be substantively equivalent to claim 38 as discussed above.

As for claim 40, Fielibert further shows electrode (needle) moveable and sized to fit the hole it makes.

As for claims 42 and 44, Fielibert shows the alternative means of forming an aperature as a needle or punch as well as an electrode.

Claims 27, 29, 32, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Fielibert et al. (US Patent 3,855,531) as modified by Karp (US Patent 1,042,558) and applied to claim 23 above and further in view of Wass (US Patent 4,528,840)

Regarding claim 27, 29, Fielibert further shows a platform in figure 3 but lacks the platform being moveable along a floor surface on devices for reducing friction between the platform and the floor surface, the clamp and the tank being mounted on the platform.

Wass teaches a test stand 10 mounted on a moveable cart 14 as shown in figure 1. The cart is shown with four wheels 22 which are devices, which will reduce friction between the cart, test stand and the floor.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a support platform, which is moveable along a floor surface on wheels. "This allows test stand ... to be moved from place-to-place, as needed, and then moved to a storage location when not in use." (column 3 lines 63-66)

As for claims 32, 33, as discussed above with respect to claims 27 Wass taught wheels advantageously reducing friction.

Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fielibert et al. (US Patent 3,855,531) as modified by Karp (US Patent 1,042,558) and Wass (US Patent 4,528,840) and applied to claims 27 and 29 above and further in view of Wise (US Patent 5,642,898)

The references lack the platform has at least one connector for removably connecting the apparatus to a source of electricity.

Wise teaches a cart 10 with a power strip 36 and plug 34.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a power strip and plug for advantageously providing electricity to various accessories (abstract) that may be carried by the cart.

Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fielibert et al. (US Patent 3,855,531) as modified by Karp (US Patent 1,042,558) and Wass (US Patent 4,528,840) and applied to claims 27 and 29 above and further in view of Albertson (US Patent 4,378,034).

The references lack the platform with at least one connector for removably connecting the apparatus to a source of pressurized air.

Albertson teaches an air line 46 releasably attached to a connector 47 mounted on top plate 37 functions to supply air under pressure to apparatus 20.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Helms (US Patent 3,418,845) in view of Konieczka (US Patent 5,535,618) and Hoffman (DE 3827744A1)

Helms discloses a can body testing machine. The recitation that testing is on "liquid-filled" containers has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

The apparatus includes a clamp having a first and second clamping elements (22, 23) or members for securing a container between the members as shown in figures 4 and 5.

Cylinder 41 with rod 43 is a ram connected to the clamping elements to provide relative movement between the first and second elements or members.

Tank 49 is a liquid-filled tank situated with respect to the clamp such that at least a portion of a container secured between the first and second members may extend into the tank and a closure of the container be submerged in the liquid as shown sequentially in figure 2 and 3.

Helms lacks a conductivity evaluating instrument including a first and second electrode, an electrode is in contact with the liquid in the container and the second electrode of the instrument being immersed in the liquid in the tank.

Konieczka teaches a seal integrity evaluation method including first and second electrodes (1, 13) wherein electrode 1is in contact with the liquid in the container 2 and the second electrode of the instrument being immersed in the liquid 9 in the tank 14. (see figure 1 and column 3 line 61 to column 4 line 38)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a conductivity evaluating instrument including a first and second electrode, an electrode is in contact with the liquid in the container and the second electrode of the instrument being immersed in the liquid in the tank. Such an instrument provides a "simple, easy to carry out, and inexpensive method for testing for

seal leaks in sealed containers having seals which can be opened and containing electrolyte product compositions."

The references also lack means for forming an aperture in a container wherein a first electrode being integrated with the means for forming an aperture such that when the means for forming an aperture penetrates a wall of a container, without removing the means for forming an aperture from the container.

Hoffman teaches a first electrode (14 or 15) inserted through a container wall thus forming an aperture and placing the electrode in contact with the liquid within. (see figures 1, 2, 3). This could occur while the container was secured in a clamp.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to insert electrodes through a container wall to come into contact with the liquid within in order to determine an electrical property of the liquid within. (See Derwent abstract)

Konieczka further teaches the sealed container is not leaking if there is no electric current flowing or electrical conductivity between the two electrodes, and the sealed container is leaking if there is electric current flowing or electrical conductivity between the two electrodes. This is considered to be substantively equivalent to electrically comparing the first and second electrodes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the potential between the electrodes as it is the basis for the "simple, easy to carry out, and inexpensive method for testing for seal leaks in sealed containers having seals which can be opened and containing electrolyte product compositions."

***Allowable Subject Matter***

Claims 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Fielibert et al. as applied above teaches vertical movement of means forming aperture but not horizontal. Franks et al. (US Patent 4,089,208) teaches means forming an aperture for container closure testing (items 38, 40, 42 and 44) that moves vertically and horizontally. However, the means moveable in order to allow formation of the aperture while the container is outside the testing water bath and would not be combinable with the combination of Fielibert et al. and Widmer et al.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Garber whose telephone number is (571) 272-2194. The examiner can normally be reached on 6:30 a.m. to 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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